REMARKS

Claims 1-66 stand rejected in the outstanding Official Action. Claims 14, 20, 36 and 58 have been amended and therefore claims 1-66 remain in this application.

Attached hereto is a marked-up version of the changes made to the claim(s) by the current amendment. The attached page(s) is captioned "**Version With Markings To Show Changes Made.**"

The Examiner's consideration of the prior art submitted with applicant's Information Disclosure Statement is very much appreciated.

The drawings stand objected to because of minor informalities. Applicant encloses herewith formal drawings which are believed to obviate the objection to the drawings.

Claims 14 and 20 have been objected to in the outstanding Official Action. The Examiner is correct and notes that the word "is" is surplusage in claim 14, and this has been corrected by amendment. Additionally, the same error was noted in claims 36 and 58, and similar corrections have been made. Further, the Examiner's suggestion that claim 20 be dependent from claim 19 is appreciated, and this amendment has been made.

In accordance with the above amendments to the claims, it is submitted that the objections to the claims have been obviated.

Claims 1, 3, 6, 8, 10, 23, 25, 28, 30, 32, 38, 45, 50, 52, 54 and 60 stand provisionally rejected under an obviousness-type double patenting objection over the claims of copending application Serial No. 09/944,114. It is noted that Serial No. 09/944,114 is a CIP of the present case and was filed after the filing date of the above

application. It would be inappropriate to disclaim any term in this case based upon the term of a subsequently filed CIP. The above was confirmed in a telephone discussion with SPE Chaki on June 16, 2003 and therefore applicant brings the erroneous basis for rejection to the Examiner's attention.

Claims 1, 2, 4-7, 12, 14, 15, 17, 22-24, 26-29, 34, 36-39, 44-46, 48-51, 56, 58-61 and 66 stand rejected under 35 USC §103 as unpatentable over Heath (U.S. Patent 6,360,366) in view of Filepp (U.S. Pub. No. 2003/0018527).

As set out in applicant's claims, applicant's invention is the utilization of a tag in computer data, which tag is indicative of the existence of an updated version of the computer file. Based upon the detection of the tag, downloading of an updated file from a predetermined source is accomplished. Versions of the invention include a program for inserting a tag within computer data and appropriate programs and methods of updating a computer file. The invention is represented by independent claims 1, 22, 23, 44, 45 and 66.

The Examiner is reminded that the Court of Appeals for the Federal Circuit has held that "the PTO has the burden under Section 103 to establish a *prima facie* case of obviousness." *In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). None of the references teach the claimed interrelationship of update triggering based upon a detected tag in the data.

With respect to the combination of references, the Federal Circuit has also held that "teachings of references can be combined *only* if there is some suggestion or

incentive to do so." *Id.* at 1599. Here the Examiner has provided no support for the allegation of it being obvious to combine these references.

The Federal Circuit has also opined that it is "error to find obviousness where references 'diverge from and teach away from the invention at hand'." *Id.* As noted above, the references all are believed to teach solutions to problems other than automated downloading of updated software versions and thus teach away from the claimed invention.

With respect to the alleged motivation for combining these references, the Examiner has provided no support. In the recent case of *In re Rouffet* , 47 USPQ2d 1453, 1458 (Fed. Cir. 1998), the Court held that "the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." Nowhere in either of the cited references does there appear to be any recognition of the problem solved by the claimed invention.

In accordance with the Federal Circuit decisions noted above, in order for the Heath and Filepp references to render obvious applicant's claims, not only must they disclose the existence of a tag "within data received by said computer," but they also most include the operating interrelationship of "operable upon detection of said tag to trigger downloading from a predetermined source."

In addition to the above noted structure and structural interrelationship, it is incumbent upon the Examiner to establish a *prima facie* case of obviousness, i.e. he must also show some motivation for combining the teachings in the two references, and if one

reference teaches away from a combination with the other reference, the Examiner must explain why one of ordinary skill in the art would not be led away from the present invention.

As the Examiner admits, "Heath does not explicitly disclose a computer program product" (page 6, section 8, third full paragraph). Additionally, and perhaps more importantly, the Examiner admits that Heath "does not specifically disclose detecting a tag wherein the tag is indicative of an updated version of said computer file." (Official Action, paragraph bridging pages 6 and 7).

In actuality, Heath discloses providing individual client control to the task of updating of files. Heath is typical of those prior art systems disclosed in applicant's specification page 2, lines 20-29, i.e. the operator requests a catalog file, he then reviews the catalog file to determine whether there are any updates and then triggers the downloading of the updated files. Because this is the conventional manner of updating files, there is no need for a tag. The reason there is no need for a tag is that Heath relies upon the source to provide the most recent version of the documentation. Without a need for any tag, there is no need for such a tag to be imbedded in data.

In summary, Heath utilizes a conventional control and update by "rendering control to the individual client rather than to a central server." (Abstract). Thus, in Heath there is no need for the insertion of a tag within or without data which indicates the existence of an updated version of the computer file, nor is there any need for software being responsive to such a tag to automatically load or download an updated file. Thus, Heath does not include applicant's claimed tag imbedded in data or the claimed

interrelationship, i.e. detecting the tag and triggering downloading from a predetermined source. Also, quite clearly there is no disclosure in Heath which even addresses the problem of applicant's invention, let alone suggests that these elements could be combined in the manner of applicants' independent claims.

Filepp, as alleged by the Examiner, includes a system for distributing advertising data across a network. The advertising data includes a header data shown in Figure 4b which includes an object version indicating byte (byte 18). A request for advertising data or object is initiated at the client computer and may be satisfied either at a local store 440 or on network 10 ("object storage facility 439 returns the requested objects to the requesting module once retrieved from either local store 440 or interactive network 10." Filepp paragraph 0185).

Filepp teaches that "only latest version of the object will be provided to guarantee currency of information to the user." (Filepp paragraph 0186). Thus, Filepp fails to teach applicant's claimed interrelationship, i.e. that there is an update triggering code which is "operable upon detection of said tag to trigger downloading from a predetermined source." How or where the Examiner believes there is any update triggering code in Filepp is not seen and clarification is requested.

However, even **if** Filepp did contain the disclosure of the interrelationship in applicant's independent claims, i.e. that upon detection of the tag within data there is an update triggering code for triggering downloading from a predetermined source, there is no discussion or motivation disclosed in the Official Action for combining the Heath and Filepp references.

Neither reference deals with the problem set out in applicant's background of the disclosure, i.e. the conventional system in which a client downloads a listing to determine whether he has the most up-to-date software and whether there are any updates and then triggers a download of the necessary application files as appropriate. This is discussed in detail in applicant's specification on page 2, lines 20-29. There is certainly no disclosure that Heath is aware of any problem, and because it doesn't mention the existence of tags within data received by the computer, it certainly can't contain any recognition of any problem being solved by such a tag or by the software operable upon detection of said tag.

Filepp contains no recognition of the problem and indeed is further removed from the claimed invention than the Heath reference, even though it arguably discloses a tag in the header data. In Filepp, the version data associated with the application programs would already be held at the client computer, and thus there would be no receipt of tag data indicative of a need to update computer files.

Thus, under the Federal Circuit decisions, not only do Heath and Filepp fail to disclose the elements of the combination (the interrelationship specified that the update triggering code is "operable upon detection of said tag to trigger downloading from a predetermined source"), but they fail to provide any motivation or rationale for combining bits of the two references. In this instance, the Filepp and Heath references actually teach away from applicant's claimed combination. They teach two totally separate methods of updating software, neither of which is applicant's claimed method or apparatus. The computer in Heath is not using the claimed computer file which may or

may not be subject to the update, but rather it is assembling catalog data indicative of the latest versions of different computer files. Further, Heath teaches not inserting a tag within data, and therefore the Examiner has not explained why one would ignore the Heath teaching and instead utilize the Filepp teaching of the so-called "tag" in the header data. Finally, even if the Examiner were correct and there is some reason for attempting to combine the Heath and Filepp teachings in the manner of applicant's claim 1 (assuming that this is not 20/20 hindsight), even if they were literally combined, it would not produce the system set out in applicant's independent claims, i.e. a tag code operable to detect within data received by a computer a tag and update triggering code "operable upon detection of said tag to trigger downloading."

As a result of the above, it is clear that the features of each of applicant's independent claims 1, 22, 23, 44, 45 and 66 are missing from the Heath and Filepp combination and any further rejection of any of the claims in this application based on this combination is respectfully traversed.

Claims 3, 25 and 47 stand rejected under 35 USC §103 as unpatentable over the Heath/Filepp combination and further in view of Cheng (U.S. Patent 6,151,643). The above comments with respect to the impropriety of the Heath/Filepp combination are herein incorporated by reference. It is noted that the Examiner does not indicate that Cheng supplies the missing interrelational element of applicant's independent claims, nor is there any allegation that Cheng contains any motivation for combining the three disparate references. Quite clearly, the Examiner has failed to establish a *prima facie*

case of obviousness and any further rejection of claims 3, 25 and 47 over the Heath/Filepp/Cheng combination is respectfully traversed.

Claims 8-11, 13, 16, 21, 30-33, 35, 43, 52-55, 57 and 65 stand rejected under 35 USC §103 as unpatentable over the Heath/Filepp combination in view of Hodges (U.S. Patent 6,053,423). Because the rejection of these claims is based upon the Heath/Filepp combination, the above comments on this combination are herein incorporated by reference. Again, there is no allegation by the Examiner that Hodges teaches the missing interrelationship set out in applicant's independent claims.

Moreover, the Examiner's conclusory allegation that it would be obvious to combine the references ignores the Federal Circuit requirement of some motivation or reason apparent from the record for making such combinations. The Examiner is merely attempting to take bits and pieces from a plurality of prior art references and reconstitute them in the manner of applicant's independent claims. Certainly the claims dependent from applicant's independent claims cannot be so easily reconstituted. Because the Examiner has failed to meet the burden placed upon the Patent Office with respect to supporting a rejection under 35 USC §103, these claims are clearly patentable over the Heath/Filepp/Hodges combination.

Claims 18, 19, 40, 41, 62 and 63 stand rejected under 35 USC §103 as unpatentable over Heath in view of Filepp and in further view of Cowan (U.S. Patent 6,031,830). Inasmuch as this rejection is based upon the Heath/Filepp combination, the above comments relating thereto are herein incorporated by reference.

Again, the Examiner makes no allegation that Cowan teaches the missing interrelationship in applicant's independent claims which is missing from the Heath/Filepp combination. Additionally, the Examiner makes only conclusory statements as a basis for combining portions of the references ("it would have been obvious for one of ordinary skill in the art at the time the invention was made . . ."). There is no motivation for combining the bits and pieces of the Heath/Filepp/Cowan references, but even if there were such a combination, because none of the references teach the claimed interrelationship in applicant's independent claims, "update triggering code operable upon detection of said tag to trigger downloading from a predetermined source," there is no *prima facie* case of obviousness under 35 USC §103.

Claims 20, 42 and 64 stand rejected under 35 USC §103 as unpatentable over Heath in view of Filepp and Cowan and further in view of Lambert (U.S. Patent 6,038,601). The above discussion of Heath in combination with Filepp, as well as the discussion of Heath/Filepp in combination with Cowan, is herein incorporated by reference.

The Examiner fails to indicate that the Lambert reference supplies the missing interrelationship specified in applicant's independent claims, from which claims 20, 42 and 64 depend. Without this limitation, any combination of prior art references fails to render obvious the claims. Moreover, the Examiner has failed to provide any motivation or rationale for combining the references in the manner of applicants' claims, save for the 20/20 hindsight reasoning disclosed in applicant's specification. As a result, there is no *prima facie* case of obviousness of claims 20, 42 and 64 under 35 USC §103.

Having responded to all objections and rejections set forth in the outstanding Official Action, it is submitted that claims 1-66 are in condition for allowance and notice to that effect is respectfully solicited. In the event the Examiner is of the opinion that a brief telephone or personal interview will facilitate allowance of one or more of the above claims, he is respectfully requested to contact applicant's undersigned representative.

Respectfully submitted,

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Enclosures:
Formal Drawings

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS

14. *(Amended)* A computer program product as claimed in claim 1, wherein said predetermined source [is] contains an updated version of said computer file provided by a supplier of said computer file.

20. *(Amended)* A computer program product as claimed in claim [15] 19, wherein said failure delay period is a psuedo-ransom value determined by said update triggering code.

36. *(Amended)* A method as claimed in claim 23, wherein said predetermined source [is] contains an updated version of said computer file provided by a supplier of said computer file.

58. *(Amended)* Apparatus as claimed in claim 45, wherein said predetermined source [is] contains an updated version of said computer file provided by a supplier of said computer file.